

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. Claims 1, 5-7, 11-15, and 17-19 are amended. No new material was added. Reconsideration of the claims is respectfully requested.

I. Interview Summary

On July 18, 2006 the Examiner and the undersigned attorney discussed the rejections under 35 U.S.C. §101 and the rejections under 35 U.S.C. §102, as well as the proposed claim amendments presented herein. No agreement was reached. The Examiner is invited to call the undersigned attorney if, in the opinion of the Examiner, another telephone conference would expedite allowance of the application.

II. 35 U.S.C. § 101

The Examiner rejected claims 1-20 as directed towards non-statutory subject matter. This rejection is respectfully traversed. The Examiner states that:

Claims 1-20 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-20, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "*useful, concrete and tangible result.*" *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward protecting document content in a multi-user environment from deletion. Applicant's claims describe the steps taken to manipulate (determine and prevent) the nonfunctional descriptive material (the document content), but fail to provide a tangible result. The application describes a useful result on page 14, regarding, Figure 5, wherein a pop-up window notifies the user of the inventive function occurring, however the claims 1-20 fail to positively claim such a feature. Dependent claims 3, 9 and 15 are directed toward "generating an indication", however this feature fails to be useful unless the indication is given to the user, for instance, as the display shown in Figure 5.

Office Action dated April 28, 2006, pp. 2-3.

Contrary to the Examiner's assertions, all claims comply with the standards presented in the MPEP and as required by accepted case law. For example, claim 1 as amended is as follows:

1. A method in a data processing system for modifying a word processing document, the method comprising:
 - selecting a first portion of text to be protected from deletion from the word processing document, wherein the word processing document is not a spreadsheet, and wherein the first portion of text to be protected from deletion forms protected content;
 - responsive to receiving a user input to delete selected content within the document, determining whether a second portion of the selected content contains any of the protected content; and
 - responsive to the second portion of the selected content containing the protected content, preventing deletion of the protected content.

Claim 1 is directed towards a method *in a data processing system* for modifying a word processing document. Regarding this type of claim, the MPEP states the following:

The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

MPEP, §2106(1)(b)

The rejection is incorrect in view of the MPEP guidelines covering patentability of claims directed towards non-functional descriptive material. The method of claim 1 is similar to the example given above. Analogous to the example, the claimed data processing system recognizes a first portion of text to be protected from deletion from the word processing document read from memory and upon recognizing a user input to delete selected content containing the protected content, prevents deletion of the protected content. Therefore, a functional interrelationship exists among that data and the computing processes performed when utilizing that data is defined. For this reason claim 1 implements a statutory process. Accordingly, claim 1 is statutory under 35 U.S.C. §101.

Furthermore, the claimed invention provides a "useful, concrete and tangible result." The MPEP states the following in regards to the utility requirement:

If the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.

MPEP §2107 (II)(B)(1)

In the case at hand, Applicants have asserted the usefulness of the claimed invention as claimed in claim 1. As stated in the specification on page 2, the present invention provides an improved method, apparatus, and computer instructions for managing the deletion of content in a document. The present invention decreases the number of revisions and time needed to complete a document by not allowing deletion of protected content. Therefore, the present invention as claimed in claim 1 provides a utility as assessed from the perspective of one of ordinary skill in the art in view of the disclosure.

Furthermore, the Examiner erroneously asserts that because claim 1 does not claim a feature in which an indication is generated to the user, the present invention fails to be useful. The USPTO guidelines for evaluating whether a practical result is achieved are as follows:

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

USPTO, Interim Guideline of October 26, 2005.

As stated above, the final results are useful in that the present invention decreases the number of revisions and time needed to complete a document by not allowing deletion of protected content. The fact that the user is not expressly notified does not render the final result useless. Therefore, the final result achieved by the claimed invention is "useful, tangible and concrete." Furthermore, because the process is implemented in a physical data processing system, the final result achieved by the claimed invention is tangible and concrete. Therefore, claim 1 is statutory subject matter under 35 U.S.C. §101.

Additionally, similar patent claims have been allowed in which the user is not expressly notified of actions performed by the data system. For example, the following claim has been allowed:

1. A method implemented in a computer program application performing operations on documents having states, the method comprising: the application maintaining in a memory a state history of a document; and whenever an interesting operation has occurred, an interesting operation being an operation by the application that changes the state of the document in response to a user command, automatically capturing the state of the document as it exists after the operation and adding the captured state to the state history of the document, the captured state of the document being complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse effect on later document states.

Hamburg, et al, Maintaining document state history, U.S. Patent 7,062,497 (June 13, 2006). Because Applicants are entitled to have their application examined on par with all other applicants, and because other, similar, claims have been allowed, the Examiner should also allow claim 1.

Additionally, Applicants are under no requirement to recite in the claims themselves the purpose of the claimed invention. For example, the interim guidelines provide that:

Accordingly, *a complete disclosure* should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

USPTO, Interim Guideline of October 26, 2005, page 4.

The guidelines provide that the *disclosure* should contain some indication of the practical application for the claimed invention. However, the practical application need not appear in the text of the claims. Instead, only features necessary to implement the practical application must appear in the text of the claim.

Therefore, Applicants have shown that all the claims contain features which make the claims statutory under 35 U.S.C. §101, as provided by the MPEP, the interim guidelines, and the standards of accepted case law. Accordingly, the rejection of claims 1-20 under 35 U.S.C. §101 is in error and should be withdrawn.

III. 35 U.S.C. § 102, Asserted Anticipation

The Examiner rejected claims 1-5, 7-11, 13-17 and 19-20 as anticipated by Microsoft Excel 2000, copyright 1999 by Microsoft Corporation (hereinafter *Excel*). This rejection is respectfully traversed.

The Examiner states that:

Claims 1-5, 7-11, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Excel 2000, copyright 1999 by Microsoft Corporation (hereinafter *Excel*). The examiner has provided screen snapshots of the *Excel* spreadsheet program in support of the rejection described herein.

Regarding independent claim 1, *Excel* discloses modifying a document in a data processing environment. Applicant's disclosure indicates that applicant's definition of a document includes documents generated by programs including word processors, spreadsheet programs, web design programs, and publishing programs (page 1, second and third paragraphs of the originally filed specification). *Excel* is well known as a spreadsheet program that provides for the generation and modification of spreadsheet documents.

Excel allows a user to select content within a document for deletion. *Excel* can determine whether the selected content is protected from deletion. *Excel* can prevent the deletion of the content. Figure 2 of *Excel* shows a spreadsheet. Figure 3 of *Excel* shows a user selection of spreadsheet cell C5. The user has selected the Delete key from the keyboard (not shown). *Excel* has responded to the delete request by the message shown in Figure 4 indicating that the cell is protected and cannot be modified. *Excel* has prevented the deletion of the content.

Office Action dated April 28, 2006, pp. 4-5.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re*

Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims. Claim 1 as amended is as follows:

1. A method in a data processing system for modifying a word processing document, the method comprising:
selecting a first portion of text to be protected from deletion from the word processing document, wherein the word processing document is not a spreadsheet, and wherein the first portion of text to be protected from deletion forms protected content;
responsive to receiving a user input to delete selected content within the document, determining whether a second portion of the selected content contains any of the protected content; and
responsive to the second portion of the selected content containing the protected content, preventing deletion of the protected content.

In regards to claim 1, Applicants have amended claim 1 to overcome the cited reference. *Excel* as stated by the Examiner is well known as a spreadsheet program that provides for the generation and modification of spreadsheet documents. Applicants have amended claim 1 to state “wherein the word processing document is not a spreadsheet.” Likewise, Applicants have amended the remaining independent claims 7, 13, and 19 in the same manner. Therefore, the rejection of claims 1, 7, 13, and 19 under 35 U.S.C. §102 has been overcome.

Because claims 2-5, 8-11, 14-17, and 20 depend from claims 1, 7, 13, and 19 respectively, the same distinctions between *Excel* and claims 1, 7, 13, and 19 apply to the preceding dependent claims. Additionally, claims 5, 11, and 17 claim other additional combinations of features not suggested by the reference. Claims 5, 11, and 17 claim a protected content that is at least one of text and a graphic image. *Excel* does not protect against deletion of a graphic image. The Examiner does not assert otherwise. Consequently, the rejection of claims 1-5, 7-11, 13-17 and 19-20 has been overcome.

IV. 35 U.S.C. § 103, Asserted Obviousness

The Examiner rejected claims 6, 12, and 18 as obvious over *Excel* under 35 U.S.C. §103. This rejection is respectfully traversed. The Examiner states that:

Regarding dependent claim 6, *Excel* discloses the use of a filter in Figure 7, however *Excel* fails to disclose the use of a grep Filter. However, applicant's disclosure describes a grep filter as: "A grep filter searches line by line for a specific pattern and outputs any line that matches the pattern" (page 13, second

paragraph of the originally filed specification). Excel discloses in Figure 7, an advanced filter that filters the list in place, within a specified range in a sequential manner. So although Excel fails to explicitly describe a grep filter, Excel's filter is obviously performing the same function. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use the filtering functions of Excel as a grep filter in order to sequential review specific data.

Regarding claims 12 and 18, the claims are directed toward a system and a computer readable media, respectively, for the method of claim 6, and are rejected using the same rationale.

Office Action dated April 28, 2006, pp. 6-7.

Regarding claim 6, the Examiner cannot establish a *prima facie* obviousness rejection because the proposed modification does not teach or suggest all of the features of claim 6. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the presently claimed invention have been considered and the teachings of the reference do not teach or suggest the claimed subject matter to a person of ordinary skill in the art.

Claim 6 is as follows:

6. The method of claim 1, wherein the determining step includes using a grep filter to identify the protected content.

Addressing the rejection of claim 6, the examiner cannot establish a *prima facie* obviousness rejection because *Excel* does not teach or suggest all the features of claim 1 as amended, from which claim 6 depends. As previously stated, claim 1 has been amended with the additional limitation, “wherein the word processing document is not a spreadsheet.” Accordingly, the Examiner cannot establish a *prima facie* obviousness rejection of claim 6.

Furthermore, as the Examiner admits, *Excel* does not teach the claimed feature of a “grep filter.” The Examiner asserts this feature is taught through the following figure:

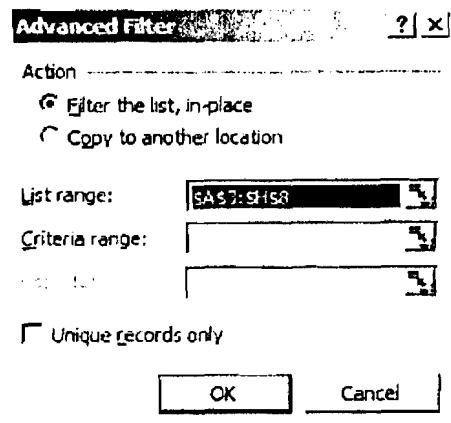


Figure 7

This figure does not adequately teach or suggest the use of a “grep” filter. The mere fact that the figure indicates the ability to filter a list does not teach the specific features of a grep filter. As stated in the specification on page 13, a grep filter searches line by line for a specific pattern and outputs any line that matches the pattern. Additionally, the specification states filters may be implemented using any filtering or parsing process that can identify content that has been marked for protection. This fact indicates that the advanced filter provided in *Excel* may filter using a different process than a grep filter. Because figure 7 does not explicitly or impliedly teach the specific use of a grep filter, *Excel* does not teach or suggest all the features of claim 6.

Thus, the Examiner cannot establish a *prima facie* obviousness rejection of claim 6. Similarly, the Examiner cannot establish a *prima facie* obviousness rejection of claims 12 and 18. Consequently, the rejection of claims 6, 12, and 18 under 35 U.S.C. §103 has been overcome.

V. Conclusion

It is respectfully urged that the subject application is patentable over *Excel* and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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